

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Stephen Solomon et al.

Application No.: 10/702,194

Filed: November 4, 2003

For: FOOD EXTRACTION APPARATUS
AND METHOD

Appeal No.: 2008-4105

Group Art Unit: 3761

Examiner: Melanie Hand

Board of Patent Appeals and Interference
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

REQUEST FOR REHEARING UNDER 37 C.F.R. § 41.52

In response to the Decision on Appeal dated December 1, 2008, in the above-identified application, Appellants respectfully submit this Request for Rehearing. Although no fees are believed due in connection with this paper, the Commissioner is authorized to charge any required fees to Deposit Account No. 16-2500.

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ARGUMENT

On page 10 of the Decision (at lines 1-6), the Board noted Appellants' contention that "it would not be obvious to modify the method of Shapiro to treat obese patients because there is no suggestion or teaching in Shapiro of using any of the animal models for treatment of eating disorders." To counter Appellants' contention, the Decision relies on FF1, and reaches the conclusion that "Shapiro includes a direct suggestion that an animal model may serve as a treatment."

Appellants submit that in reaching that conclusion, the Board misapprehended Shapiro, and Appellants further submit that FF1 is insufficient to rebut Appellants' contention. For although Shapiro teaches that an animal model may serve as a treatment in general, it never suggests that sham feeding should be used as a treatment for obesity. To the contrary – Shapiro actually suggests that the opposite is true, as explained in the following paragraph.

Shapiro teaches that an "intervention at any level that decreases food intake is a potential model of anorexia but also a treatment of obesity and bulimia" (FF1, from the Decision at p. 4, line 23 – p. 5, line 2). As a result, following Shapiro's teachings would lead a person looking for obesity treatments to try regimens that decrease food intake, and avoid regimens that increase food intake. But since Shapiro also teaches that sham feeding increases meal size (see FF7 in the Decision at p. 5, lines 24-26, and the Decision at p. 7, lines 18-20), following Shapiro's teachings would actually lead a person to avoid sham feeding as a treatment of obesity.

The arguments set forth in last paragraph of page 9 of the Decision are therefore flawed, and Appellants therefore respectfully ask the Board to reverse the rejection of claims 32-34.

In addition, after recognizing that patient obesity is a limitation in the claims, the Decision again relies on the fact that “any intervention at any level that decreases food intake is ... a treatment for obesity (see page 11, lines 10-19 of the Decision, citing Shapiro 117 and FF1). The decision then goes on to conclude that sham feeding is a “predictable method for obesity treatment” despite the fact that sham feeding increases meal size (see FF7 in the Decision at p. 5, lines 24-26, and the Decision at p. 7, lines 18-20), which totally undercuts the reasoning relied on by the Board in support of the rejections. In fact, Shapiro teaches that sham feeding increases meal size by a factor of 3-6 times (see FF7 in the Decision at p. 5), which should have made it highly unsuitable as a treatment for obesity (since treatments that decrease meal size are indicated for obesity). This logical inconsistency provides an additional and independent reason why the rejection of claims 32-34 should be reversed.

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Respectfully submitted,

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